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EXAMINER
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HUNTER, ALVIN A

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/625,294

Applicant(s)

PARR, W. DONALD

Examiner

Alvin A. Hunter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-8,10-22,24-30 and 32-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8,10-22,24-30 and 32-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

Regarding claim 30, the specification does not disclose having a putter head of a greater mass than a second putter head, only that a first putter has a high-density and the second club head has a low-density. Because the materials are different this does not set forth that the masses would be different because there is nothing within the specification that states that each club head in the set is made of a unitary material.

2. The amendment filed October 25, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

- a) slot be vertical in the order of one-half to three-quarter inch;
- b) lower rail from one-eighth to one-quarter inch; and
- c) the putter head made of zirconium.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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3. Claims 18-22, 24, and 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not disclose the front face of the putter head being between one to five degrees; only 0 to 10 degrees (See page 6, lines 23 through 25).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 4, 6-8, 14-20, 22, 24, 26, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sundin (USPN 5584769).

Regarding claim 1, Sundin discloses a putter 10 comprising a shaft 14 having a proximate end and a distal end, a grip 26 affixed to the proximate end of the shaft, a putter head 12 affixed to the distal end of the shaft wherein the putter head comprises a unitary block of metal and the putter head comprises a front face 16 and a toe face each operative to be used as a striking surface for propelling a golf ball (See Figure 1 and Column 3, lines 50 through 58). Applicant does not disclose why it is critical to have a slot disposed in a longitudinal direction across the entirety of the back face of the putter

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head in order to attain the invention. Evidence is submitted in the sentence bridging pages 5 and 6 of the applicant's specification. One having ordinary skill in the art would have sought such to be an obvious matter of design choice. The putter head of Sundin would perform equally well because it allows the user to strike the ball using more than one striking face. Sundin shows the putter head having a curvature at the trailing edge of the sole face proximate the back face (See Figure 1). Applicant does not disclose why the bevel disposed at the trailing edge of the sole face proximate the back face is critical in order to attain the invention. One having ordinary skill in the art would have found it obvious to use any type of configuration, such as the curve edge of Sundin, in order to prevent stubbing.

Regarding claim 2, Sundin discloses the putter further having a heel face capable of being used as a striking surface for propelling a golf ball (See Figure 2).

Regarding claim 4, Sundin shows the face angle of the toe face, the face angle of the front face and the shaft angle configured such that a player addressing a golf ball with the toe face nearest the golf ball or with the front face nearest the golf ball will be addressing the golf ball with a face at substantially the same angle with respect to vertical (See Figures 2 and 3).

Regarding claims 6 and 19, Applicant does not disclose why it is critical to have a slot disposed in a longitudinal direction across the entirety of the back face of the putter head in order to attain the invention. One having ordinary skill in the art would have sought such to be an obvious matter of design choice. The putter head of Sundin

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would perform equally well because it allows the user to strike the ball using more than one striking face.

Regarding claim 7, Sundin shows the interface between the front face and the sole face of the putter head is radiused (See Figure 1 and 3).

Regarding claims 8 and 20, Applicant does not disclose why it is critical for the radius to be from  $1/8$  to  $3/8$  of an inch in order to attain the invention. One having ordinary skill in the art would have found such to be an obvious matter of design choice. The radius of Sundin would perform equally well because it prevents stubbing when cocking the putter or stroking the golf ball (See Column 2, lines 34 through 48).

Regarding claims 14, 15, 21, and 22, Applicant does not disclose why it is critical for the length and height to be of a particular value in order to attain the invention. One having ordinary skill in the art would have found such to be an obvious matter of design choice. The dimension of the club head of Sundin would perform equally well because it prevents stubbing during play (See Column 2, lines 34 through 48). Alternately, one skilled in the art would have drawn from Sundin that the putterhead can be of any size so long as the invention is attainable and, therefore, would have been obvious.

Regarding claim 16, Sundin shows the angle of the front face with respect to vertical being about 0 degrees (See Figure 1). One having ordinary skill in the art would have found it obvious to have the front face of about 0 degrees from vertical because it is commonly used within the art of golf club heads.

Regarding claims 17 and 24, Sundin shows the angle of the back face 18 with respect to vertical being about 40 degrees since angle  $\beta$  is  $130^\circ$  from a third common

edge (See Figure 1). One having ordinary skill in the art would have found it obvious to have the front face of about 40 degrees from vertical in order to assist in chipping shots.

Regarding claim 18, Sundin discloses a putter 10 comprising a shaft 14 having a proximate end and a distal end, a grip 26 affixed to the proximate end of the shaft, a putter head 12 affixed to the distal end of the shaft wherein the putter head comprises a unitary block of metal and the putter head comprises a front face 16, a toe face, and a back face 18 each operative to be used as a striking surface for propelling a golf ball (See Figure 1 and Column 3, lines 50 through 58). Sundin also shows the face angle of the toe face, the face angle of the front face and the shaft angle configured such that a player addressing a golf ball with the toe face nearest the golf ball or with the front face nearest the golf ball will be addressing the golf ball with a face at substantially the same angle with respect to vertical (See Figures 2 and 3). Applicant does not give any criticality to the placement of the shaft along the putter head. One having ordinary skill in the art would found the placement of the shaft to be an obvious matter of design choice. The shaft of Sundin would perform equally as well because it allows the user to swing the putter head.

Regarding claim 26, Sundin discloses a putter comprising a shaft 14 having a proximate end and a distal end, a grip 26 affixed to the proximate end of the shaft, a putter head 12 affixed to the distal end of the shaft wherein the putter head comprises a front face 16, top face, and sole face wherein each of the faces being substantially planar in character and the sole face being substantially parallel to and substantially wider than the top face (See Figure 1 and 3).

Regarding claims 33-35, Applicant does not disclose why it is critical to have a slot on the back face of the putter head in order to attain the invention. Evidence is submitted in the sentence bridging pages 5 and 6 of the applicant's specification. One having ordinary skill in the art would have sought such to be an obvious matter of design choice. The putter head of Sundin would perform equally well because it allows the user to strike the ball using more than one striking face.

5. Claims 30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sundin (USPN 5584769) in view of Schooler (USPN 5692969).

Regarding claim 30, Sundin discloses a putter 10 comprising a shaft 14 having a proximate end and a distal end, a grip 26 affixed to the proximate end of the shaft, a putter head 12 affixed to the distal end of the shaft wherein the putter head comprises a unitary block of metal and the putter head comprises a front face 18. Sundin also notes that the club may be made of different materials such as steel, aluminum, etc. which inherently have different densities and masses. Sundin does not disclose two clubs but one having ordinary skill in the art would have found it obvious to have two clubs have the same approximate dimensions in order to accommodate multiple users. Furthermore, one having ordinary skill in the art would have found it obvious to have a mass of one club greater than another in order to adjust the moment of inertia of the club head. Sundin does not disclose the angles of the first and second shaft being different. Schooler discloses a golf putter wherein angle of the shaft may be varied to the user's needs (See Summary of the invention). Though Schooler teaches the angle on one club head being adjustable, having a set of putters having angle through that of



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Schooler's would perform the same. Therefore, one having ordinary skill in the art would have found it obvious to have shafts of any angle on putter heads, as taught by Schooler, in order to perform a particular shot.

Regarding claim 32, Sundin disclose that the front face may have an angle any where between 130 to 170 degrees wherein the angle variation is dependent upon the need of the user (See Column 2, lines 34 through 43). One having ordinary skill in the art would have found it obvious to have the front face angle of the club heads of different angles in order to address the needs of the user.

6. Claims 5, 25, 26 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sundin (USPN 5584769) in view of Meek (USPN 5297603).

Regarding claims 5, 25, and 26, Sundin does not discloses the putter having a putter head cover. Meek discloses a club head cover (See abstract). Applicant does not disclose why it is critical for the club head to have planar faces or to have only a detent in order to attain the invention. One having ordinary skill in the art would have found such to be an obvious matter of design choice. The club head cover of Meek would perform equally the same because it protects the club head from being damaged.

Regarding claim 36, Sundin discloses a putter 10 comprising a shaft 14 having a proximate end and a distal end, a grip 26 affixed to the proximate end of the shaft, a putter head 12 affixed to the distal end of the shaft wherein the putter head comprises a unitary block of metal and the putter head comprises a front face 16, a toe face, and a back face 18 each operative to be used as a striking surface for propelling a golf ball (See Figure 1 and Column 3, lines 50 through 58). Sundin also shows the face angle of

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the toe face, the face angle of the front face and the shaft angle configured such that a player addressing a golf ball with the toe face nearest the golf ball or with the front face nearest the golf ball will be addressing the golf ball with a face at substantially the same angle with respect to vertical (See Figures 2 and 3). Applicant does not give any criticality to the placement of the shaft along the putter head. One having ordinary skill in the art would find the placement of the shaft to be an obvious matter of design choice. The shaft of Sundin would perform equally as well because it allows the user to swing the putter head. Sundin also shows the angle of the back face 18 with respect to vertical being about 40 degrees since angle  $\beta$  is  $130^\circ$  from a third common edge (See Figure 1). One having ordinary skill in the art would have found it obvious to have the front face of about 40 degrees from vertical in order to assist in chipping shots. Sundin also shows the angle of the front face with respect to vertical being about 0 degrees (See Figure 1). One having ordinary skill in the art would have found it obvious to have the front face of about 0 degrees from vertical because it is commonly used within the art of golf club heads. Applicant does not disclose why it is critical for the length and height to be of a particular value in order to attain the invention. One having ordinary skill in the art would have found such to be an obvious matter of design choice. The dimension of the club head of Sundin would perform equally well because it prevents stubbing during play (See Column 2, lines 34 through 48). Alternately, one skilled in the art would have drawn from Sundin that the putterhead can be of any size so long as the invention is attained and, therefore, would have been obvious. Applicant does not disclose why the bevels are critical in order to attain the invention. One having ordinary skill in the art

would have found it obvious to use any type of configuration, such as the curve edges of Sundin, in order to prevent stubbing.

7. Claims 10, 11, 18, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sundin (USPN 5584769) in view of Lin (USPN 5700206).

Regarding claims 10, 11, 18 and 27, Sundin discloses a putter 10 comprising a shaft 14 having a proximate end and a distal end, a grip 26 affixed to the proximate end of the shaft, a putter head 12 affixed to the distal end of the shaft wherein the putter head comprises a unitary block of metal and the putter head comprises a back face 18, a toe face, heel face, and sole face. Sundin does not disclose the putter having a bevel on the sole face or having a slot across the back face. Lin discloses a putter having a sole face 15 wherein the sole face comprises a first bevel 16 disposed at the interface of the sole face and the toe face 13 of the putter head and a second bevel 17 disposed at the interface of the sole face and the heel face 11 of the putter head (See Paragraph bridging columns 2 and 3 and Figure 1). One having ordinary skill in the art would have found it obvious to incorporate a bevel into Sundin, as taught by Lin in order to have the striking face perpendicular to the ground when addressing the golf ball. Applicant does not disclose why it is critical to have a slot disposed in a longitudinal direction across the entirety of the back face of the putter head in order to attain the invention. One having ordinary skill in the art would have sought such to be an obvious matter of design choice. The putter head of Sundin would perform equally well because it allows the user to strike the ball using more than one striking face.

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8. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sundin (USPN 5584769) in view Bristow et al. (USPN 6001495).

Regarding claim 12, Sundin does not disclose that the putter head is made of Ti-64 titanium. Bristow et al. discloses that Ti-64 is common used for fabricating club heads (See Background of the invention). One having ordinary skill in the art would have found it obvious to fabricated the putter head of Ti-64, as taught by Bristow et al., because it is common within the art of golf club heads.

9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sundin (USPN 5584769) in view of McCormick (USPN 4314863).

Regarding claim 13, Sundin does not disclose the putter head made of 17-4 stainless steel. McCormick discloses that it is common within the art to produce a golf club head (See Background of the Invention). One having ordinary skill in the art would have found it obvious to fabricate a putter head of 17-4 stainless steel, as taught by McCormick, because the material readily available and used within the art of golf club heads.

10. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sundin (USPN 5584769) in view Lin (USPN 5700206) further in view of Bristow et al. (USPN 6001495).

Regarding claim 28, Sundin in view of Lin does not disclose that the putter head is made of Ti-64 titanium. Bristow et al. discloses that Ti-64 is common used for fabricating club heads (See Background of the invention). One having ordinary skill in

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the art would have found it obvious to fabricate the putter head of Ti-64, as taught by Bristow et al., because it is common within the art of golf club heads.

11. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sundin (USPN 5584769) in view of Lin (USPN 5700206) further in view of McCormick (USPN 4314863).

Regarding claim 29, Sundin in view of Lin does not disclose the putter head made of 17-4 stainless steel. McCormick discloses that it is common within the art to produce a golf club head (See Background of the Invention). One having ordinary skill in the art would have found it obvious to fabricate a putter head of 17-4 stainless steel, as taught by McCormick, because the material readily available and used within the art of golf club heads.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-31 have been considered but are moot in view of the new ground(s) of rejection.

In regarding to the specification objection of claim 30, applicant argues that the subject matter is supported. The examiner disagrees. Page 12 does not assert that the materials within the club head are the sole materials used within the club head; only that they are made of different materials having different densities. A putter may contain a high-density material but it does not exclude the putter from having a low-density material within the same putter and vice versa. Applicant has not clearly conveyed what is meant by high-density material and low-density material putter. Also, dimensions do not distinguish the art if the dimensions do not have any utility different from that of the

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prior art (See Gardner v. TEC Systems, Inc., et al., 220 USPQ 777). Furthermore, applicant recites that the slot is not necessary in order to attain the invention. Applicant has clearly admitted that the slot has not utility within the claimed invention, only and aesthetic feature. For these reason the above rejection has been furnished.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is (571) 272-4411. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Vidovich, can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AAH

Alvin A. Hunter, Jr.

  
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